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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,231	01/02/2004	Henry Brian Barry	P-1880	1116
7590	08/30/2006		EXAMINER	
Charles J. Prescott, P.A. Suite 115 2033 Wood Street Sarasota, FL 34237			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
				3724

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/751,231	BARRY, HENRY BRIAN	
	<b>Examiner</b> Jason Prone	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 January 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) 15 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/2/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In this case, the abstract appears to be over the 150-word limit.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: In Figures 1, 2, and 5, items "H" and "N". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

3. Claim 4-6, 11-13, and 15 are objected to because of the following informalities:

In regards to claim 4, 6, 11, and 13, the phrase "has a thickness in the range of about 1/8" is not supported in the specification. On page 5 lines 18-19, the specification discloses "having a thickness of 1/8". Having a thickness "of" 1/8 is not the same as "in the range of about" 1/8". For example, the specification's disclosure only supports a thickness that can be exactly 1/8" while the claimed dimensions could be a little greater or less than 1/8".

In regards to claims 5, 6, 12, and 13, the phrase "shield has a width and a height of about 5" is not supported in the specification. On page 6 lines 4-5 of the specification only provides disclosure of the preferred sizes that do not correspond with the claimed sizes.

In regards to claim 15, paragraph 6, discloses the phrase "a threaded nut engaged over the rear blade tensioning member against a portion of said shield..." is not correct. The "rear blade tensioning member" is assumed to be the same structure as previously disclosed "rear blade tensioning support". As written, this would create an antecedent basis situation. Also, since the rear blade tensioning support has already been disclosed to incorporate a threaded end and the claim only discloses the threaded nut engages the rear tensioning member, one skilled in the art would assume that the

nut engages the tensioning member in another area other than the threaded end. The phrase should be-written as "a threaded nut engaged with the threaded end of the rear blade tensioning support against a portion of said shield...". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Garcher (3,727,655).

**Claim 1:**

In regards to claim 1, Garcher discloses the same invention including a universal one-piece hand guard for a hacksaw (10) and the guard comprising a semi-rigid flat shield (10) formed of a single piece of resilient non-metallic material (Column 1 lines 66-67) having a height generally equal to the frame and having a width at least as great as a projected frontal width of a user's hand when grasped around the handle (Fig. 2).

Garcher discloses the shield having a notch extending downwardly through a central portion of the shield from an upper margin (12) and the notch having a width and length sufficient to be fitted around and receive support from an upper portion of the frame at a point in proximity to and forward of the handle (Fig. 2).

Garcher discloses the shield having a mounting aperture positioned below the notch and spaced above a lower margin (14) and is capable of being sized to fit over and receive support from a threaded end of an elongated rear blade tensioning support held within a lower corner of the frame (Fig. 3).

Garcher discloses the shield is supported along the upright central portion against a rear upright portion of the frame that extends between the notch and aperture (20).

Garcher discloses the shield having sufficient resiliency for a portion to be protectively deflected around a corresponding portion of the hand upon impact against an object (Column 1 lines 21-26).

Claim 8:

In regards to claim 8, Garcher discloses a hand guard (10) comprising a resilient single piece flat shield having a height generally equal to that of the frame and having a width at least as great as a projected frontal width of a user's hand when grasped around the handle (Fig. 2).

Garcher discloses the shield having an elongated vertical notch extending downwardly along a central axis of the shield from an upper margin (12) and the notch having a width and length sufficient to be fitted around and receive support from an upper portion of the frame at a point in proximity to and forward of the handle (Fig. 2).

Garcher discloses the shield having a mounting aperture positioned below the notch and spaced above a lower margin (14) and is capable of being sized to fit over

and receive support from a threaded end of an elongated rear blade tensioning support held within a lower corner of the frame (Fig. 3).

Garcher discloses the shield is supported along the upright central portion against a rear upright portion of the frame that extends between the notch and aperture (20).

Garcher discloses the shield having sufficient resiliency for a portion to be protectively deflected around a corresponding portion of the hand upon impact against an object (Column 1 lines 21-26).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2, 3, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcher in view of Seaman et al. (6,129,622). Garcher discloses all of the claimed structure, however, Garcher fails to disclose the resilient material is neoprene.

Seaman et al. teaches that it is old and well known for shields used in a cutting environment to be made from neoprene (Column 6 lines 17-21). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Garcher with a shield made of neoprene, as taught by Seaman et al., to provide for a more sturdy shield.

8. Claims 4-7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcher in view of Seaman et al. Garcher in view of Seaman et al. disclose the invention including a shield made of suitable thickness (Column 1 line 67 of Garcher) and a shield with similar height and width measurements that correspond to the height of a conventional hacksaw (Figure 2 of Garcher).

However, Garcher in view of Seaman et al. remain silent with respect to the claimed dimensions and therefore, fail to disclose the resilient material has a thickness in the range of about 1/8", the shield has a height and width of about 5", and the neoprene has a reading of in the range of about 60.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a resilient material with 1/8" thickness, the shield with a height and width of about 5", and the neoprene has a reading of in the range of about 60 because Applicant has not disclosed that these specific dimensions provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Garcher's saw to perform equally as well as the saw of the instant application because the saws would perform the same function of protecting a users hand.

Therefore, it would have been *prima facie* obvious to modify Garcher in view of Seaman et al. to obtain the invention as specified in claims 4-7 and 11-14 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Garcher in view of Seaman et al.

Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the resilient material with a 1/8" thickness, the shield with a height and width of about 5", and the neoprene with a reading of in the range of about 60, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

***Allowable Subject Matter***

9. Claim 15 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action. If the suggested phrase were used in place of the current "objected to" phrase, the claim would be allowable because none of the prior art incorporates a threaded nut engaging with a threaded end of the rear blade tensioning support and against a portion of the shield surrounding the aperture. However, failure to correct the objection or submitting a variation of the suggest phrase may or may not lead to the claim being considered allowable.

***Response to Arguments***

10. Applicant's arguments filed 11 January 2005 have been fully considered but they are not persuasive. In Garcher, only item 10 is considered the shield and it is clearly of one-piece construction. Items 26 and 36 are not considered part of the shield and are merely shield connectors or clamps.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Michas et al. and Hartzell.

**12. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:00-4:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 21, 2006



Patent Examiner  
Jason Prone  
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